

SEP 09 2004

PATENT

Docket No.: 1232-4658IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : FUKASAWA et al.  
Serial No : 09/708,907 Group Art Unit: 2612  
Filed : November 8, 2000 Examiner: WHIPKEY, Jason T.  
For : IMAGE PROCESSING SYSTEM, IMAGE PROCESSING METHOD,  
IMAGE UPLOAD SYSTEM, STORAGE MEDIUM AND IMAGE  
UPLOAD SERVER

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Mail Stop AMENDMENT  
COMMISSIONER for PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

I hereby certify that the following items:

1. Response to Restriction Requirement;

is/are being transmitted pursuant to 37 C.F.R. §1.8 by facsimile on the date indicated below, to:

Examiner Jason T. WHIPKEY  
Group Art Unit: 2612  
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Transmission Total: 4 pages (including this cover sheet).

Respectfully submitted,  
MORGAN & FINNEGAN, LLP

Date: September 9, 2004

By:

  
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**PATENT**Docket No. **1232-4658****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE** **RECEIVED**  
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**Applicant** : TAMURA et al.  
**Serial No** : 09/708,907 **Group Art Unit:** 2612  
**Filed** : November 8, 2000 **Examiner:** WHIPKEY, Jason T.  
**For** : **IMAGE SENSING APPARATUS AND IMAGE SENSING  
METHOD, X-RAY PHOTOGRAPHING SYSTEM AND ITS  
CONTROL METHOD**

**RESPONSE TO RESTRICTION REQUIREMENT**

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S I R:

In response to the Official Action dated August 9, 2004 in which the pending claims 1-74 were subject to a Restriction Requirement, Applicant submits the following:

In the Official Action, restriction under 35 U.S.C., §121 is required to one of the following groups of inventions:

Group 1: claims 1-68 drawn to an image capturing system with storage means, classified in class 348, subclass 207.1;

Group I: claims 1-68 drawn to an image capturing system with storage means, classified in class 348, subclass 207.1;

Group II: claim 69 drawn to an image capturing system that sets a degree of importance of a captured image, classified in class 348, subclass 222.1;

Group III: claims 70-72 drawn to an image processing apparatus for displaying images on a server, classified in class 345, subclass 733; and

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Group IV: claims 73-74 drawn to an image accumulating apparatus and method for operating an image accumulating apparatus, classified in class 345, subclass 748.

Applicants provisionally elect Group I claims 1 to 68 for prosecution on the merits. This election is made with traverse.

For the reasons stated in the Office Action, it is the Examiner's position that restriction is proper because the identified inventions are distinct and have acquired separate status in the art. (See Office Action, ¶¶2-3, pages 2-3.)

Applicants respectfully do not necessarily agree with the Examiner's characterizations of the stated inventions. Moreover, while the claims each have distinct scope, the application is being restricted for 6 claims out of 74 filed claims. As indicated Applicants have provisionally elected 68 claims (i.e., Group I claims 1-68) for examination.

According to M.P.E.P. §803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; **and**
- (2) There must be serious burden on the examiner if restriction is not required.

Even assuming *arguendo* the Examiner's characterization of the inventions as being separate and distinct, the second criteria set forth above is not met. More specifically, in examining the 68 claims of Group I, also examining, e.g., claim 68 of Group II, which as admitted by the Examiner is related to Group I, or the 3 claims of Group II or the 2 claims of Group III which are also related to Group I (see ¶2, pages 2-3), would not pose a serious burden on the Examiner beyond that incurred in examining the elected 68 claims of Group I.

Applicants respectfully submit that: (1) all groups of restricted claims are properly presented in the same application; (2) undue diverse searching would not be required; and (3) all

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claims should be examined together. Applicants thus respectfully traverse the requirement for restriction on the grounds that searching all of these inventions would not be unduly burdensome and, in fact, an overlap of searching would be necessary to ensure a complete search for a proper examination on the merits of any one of the identified Groups of Inventions.

Accordingly, Applicant respectfully submits that the Requirement for Restriction is improper for at least the reasons stated, and requests that the Restriction Requirement be withdrawn and all pending claims be examined on the merits.

**AUTHORIZATION**

No fees are believed necessary in connection with this response. Should an extension of time be required, such extension is petitioned. The Commissioner is authorized to charge any fees or credit any overpayments which may be required for this paper to Deposit Account Number 13-4500, Order No. 1232-4658.

An early and favorable examination on the merits is respectfully requested.

Respectfully submitted,

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Dated: September 9, 2004

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